

Hearing:
February 16, 1999

Paper No. 106
HRW

THIS DISPOSITION IS NOT CITABLE
AS PRECEDENT OF THE TTAB

OCT. 20, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Holmes Products Corp.

v.

Honeywell Consumer Products, Inc., by change
of name of Duracraft Corporation

Opposition No. 90,210
to application Serial No. 74/236,945
filed January 13, 1992

Allen D. Brufsky for Holmes Products Corp.

Lee C. Bromberg and Julia Huston of Bromberg & Sunstein LLP
for Honeywell Consumer Products, Inc.

Before Seeherman, Hanak and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Duracraft Corporation has filed an application to
register the mark TURBO for portable electrical fans.¹

¹ Serial No. 74/236,945, filed by Duracraft Corporation on
January 13, 1992, with claimed first use dates of January 7,
1991. Applicant filed evidence of the change of name of
Duracraft Corporation to Honeywell Consumer Products, Inc. as of
November 21, 1996 and the caption of this proceeding was amended
accordingly.

Holmes Products Corp. has filed an opposition to the registration of the mark on the grounds of being merely descriptive under Section 2(e)(1) and of being a mutilation of the mark shown on the specimens.² Opposer alleges that opposer, since at least as early as January 1992, has been engaged in the manufacture and sale of portable electric fans and has been using one or more marks consisting of or comprising the word TURBO in connection therewith; that applicant's mark TURBO is merely descriptive of the goods of applicant and that opposer as a manufacturer of fans which are of a related nature to applicant's goods has a right to describe its goods with this term; that applicant's mark does not function to distinguish applicant's goods from those of others; and that, as an additional ground for opposition, the specimens filed by applicant do not show use of the mark TURBO but rather TURBO as part of one or more other marks from which TURBO cannot be severed without mutilation.

Applicant, in its answer, denied the salient allegations of the notice of opposition with respect to these two grounds.

² Opposer alleged an additional ground in its notice of opposition, namely, the likelihood of confusion under Section 2(d) based on marks registered by, or marks or trade names used by, third parties. The Board, on March 1, 1994, granted applicant's motion for partial summary judgment dismissing this ground (Holmes Products Corp. v. Duracraft Corp., 30 USPQ2d 1549 (TTAB 1994)) and the case has advanced to final hearing on the other two grounds.

The Record

The record consists of the file of the involved application; the case-in-chief testimony deposition, with exhibits, taken by opposer of Stanley Rosenzweig, chief operating officer of opposer; opposer's notice of reliance by means of which opposer introduced applicant's responses to opposer's first set of interrogatories, discovery depositions taken of three of applicant's officers and exhibits thereto, copies of three third-party registrations and the file of applicant's application S. N. 74/364,764 for the mark AIR DURACRAFT TURBO FAN;³ and the rebuttal

³ The three other categories of documents which opposer attempted to introduce by means of this notice of reliance have been objected to by applicant and the objections are upheld.

The first set of documents consists of documents produced during discovery depositions taken by applicant of opposer's witnesses. Opposer states in its reply brief that it is not relying upon these depositions and thus the objection is moot. Even if this were not the case, opposer may not rely upon its own discovery production in this manner and even documents obtained from the adverse party could not be made of record by a notice of reliance alone. See Trademark Rule 2.120(j)(3)(ii).

The next category of documents, described as printed publications, consists for the most part of newspaper advertising inserts. As noted by applicant, many of these inserts are identified only by approximate date, many are nearly illegible, and no information is given as to the particular newspapers from which the inserts were obtained. We uphold the objection on the basis that the documents are not sufficiently identified to be verified by applicant, not on applicant's further objection that the materials are in part directed to products other than portable electric fans and thus are irrelevant.

The third category is a request that the Board take judicial notice of the fact that "turbo" is descriptive of high speed and powerful objects. Opposer has since withdrawn its reliance upon this request. Moreover, this does not lie within the scope of information of which the Board may take judicial notice.

testimony deposition, with exhibits, of Stanley Rosenzweig;⁴ the trial testimony depositions, with exhibits, taken by applicant of Rodney B. Jané, president of applicant and of Bernard Chui, past president of applicant and prior to that president of Duracraft Corporation; and copies of registrations owned by applicant for the marks TURBO-AIRE and AIR DURACRAFT TURBO FAN, a copy of the file wrapper for opposer's mark TURBO BOX FAN and several dictionary definitions, all introduced by means of applicant's notice of reliance.

Mr. Rosenzweig, in his testimony in chief, stated that opposer sells electrical appliances, including fans, directly to retailers worldwide; that opposer began selling two fans under the mark TURBO-JET-AIR and a third fan under the mark TURBO BOX FAN in 1992;⁵ that the term TURBO was chosen to indicate that the fan was more powerful or "had a little more air because of its design, blade configuration, number of speeds" (SR 17:9-11); that the term "turbo" is also used by opposer on fans as a speed designation to denote the most powerful setting; and that the terms "turbine" and "turbo" are used in the industry to describe a

⁴ Applicant's objections to portions of Mr. Rosenzweig's testimony are discussed infra.

⁵ In giving his testimony, Mr. Rosenzweig referred to Exhibit 3, a declaration previously made of record in this case, to refresh his memory as to dates. Applicant has objected to the introduction of the declaration for this purpose. The objection is overruled. See FRE 612.

type of fan. In cross-examination he acknowledged that opposer had been sent a cease-and-desist letter by applicant with respect to use of the word TURBO as a mark, but could not recall whether opposer had stopped using the word TURBO as a mark on its packaging and was now using it only as a speed designation. Mr. Rosenzweig identified a collection of photocopies of advertisements by various retailers for fans, heaters and other appliances involving use of the term "turbo" which had been accumulated during the ordinary course of business by opposer in keeping track of business trends, pricing and the like (Exhibit 9).⁶

Mr. Jané, testifying on behalf of applicant, stated that the DT-7 TURBO FAN was introduced in 1991 and has been very successful ever since;⁷ that the TURBO FAN is a personal tabletop fan, 6 to 8 inches tall and 6 to 7 inches wide, circular in design with a "wind tunnel" look and a spiral front grille with a knob in the front, which comes in many vibrant colors; that "in a fun way it evokes a jet engine," but in reality is very small [RBJ 14:23-24]; and

⁶ Applicant has objected to those advertisements which are not for portable electric fans on the ground of irrelevancy. The objection is overruled. We find use of the term "turbo" in connection with other electric appliances which contain a fan mechanism such as hair dryers or convection ovens to be relevant to the issue of descriptiveness herein.

⁷ All specifics as to sales figures, extent of the market, etc. have been submitted under seal, pursuant to a stipulated protective order.

that applicant also sells other fans using the TURBO name, namely, the SUPER TURBO fan, the TURBO BOX FAN, and the TURBO-AIRE fan, the latter mark having been acquired from Seabreeze, a Canadian corporation. Mr. Jané identified Exhibits 3 and 4 as photocopies of the current packaging and sales sheet for the DT-7 TURBO FAN and Exhibit 5 as a collection of representative retail advertisements of this fan. He stated that advertising of the fan is done by retailers, "via a co-op advertising method," in circulars that go to the consumers. Mr. Jané testified that the only competitor use of the word "turbo" in connection with portable fans of which he was familiar was opposer's use and the only use of the word "turbine" was by one other competitor, against whom applicant had initiated litigation. He denied that "turbo fans" would be considered a category of portable fans.

Mr. Chui similarly testified that the TURBO FAN was designed to evoke the image of a turbine engine by means of features such as the arrangement of the grilles, the shape of the fan, the center control which is "a tipper at a angle like a propeller" and accordingly was designed to suggest that the consumer would get a relatively powerful fan despite its small size. Mr. Chui identified photocopies of both present and past packaging of the TURBO FAN (Exhibits 17 and 18), as well as sheets from catalogs first used to

introduce these fans to retailers (Exhibit 21) and subsequent thereto (Exhibit 22 and 23). Mr. Chui was aware of opposer's TURBO-JET-AIRE fan but believed that it had only been on the market for a short period of time, although long enough for instances of actual confusion with applicant's fans to occur. He stated that opposer stopped use of its TURBO marks after applicant's cease-and-desist letter and now only uses the term "turbo" as a speed setting. He identified and made of record the assignment agreement in which applicant acquired the TURBO-AIRE mark being used by Seabreeze.⁸

Opposer's rebuttal testimony, with exhibits, taken of Mr. Rosensweig is directed to opposer's first use of its TURBO-containing marks on fans. In its brief, opposer raises the issue as to whether or not applicant made valid use of its mark prior to the filing of the application and argues that opposer's prior valid use should be controlling. Applicant has objected to the testimony and accompanying exhibits on the basis that opposer's purported priority is irrelevant to the issues of this opposition. Applicant has responded to opposer's arguments with respect to non-use, but only in order to preserve its right to request a

⁸ Applicant introduced during cross-examination of Mr. Rosensweig on rebuttal a copy of the settlement agreement made between Seabreeze and opposer at a time prior to this assignment as evidence of the attempt by these two entities to curtail applicant's use of its TURBO mark.

reopening of the trial to fully present its case on the issue, if deemed relevant.

Opposer has neither pled the issue of lack of valid use by applicant prior to the filing date in the original notice of opposition nor amended the notice to add this ground. Accordingly, we will give no consideration to opposer's arguments on the issue. Furthermore, the question of opposer's first use is completely irrelevant to the two grounds of opposition before and thus applicant's objections to the rebuttal testimony and accompanying exhibits are upheld. The testimony has been given no consideration.

The Opposition

As a preliminary matter, we must clarify the grounds before us. Opposer, in the notice of opposition, alleged as a ground for opposition that TURBO is merely descriptive as applied to applicant's portable electric fans. Opposer has since attempted to expand this ground to encompass the question of genericness as well. As pointed out by applicant, genericness was not a pleaded issue, either originally or by amendment of the notice of opposition. While applicant has responded substantively to opposer's arguments, applicant has also argued that opposer is precluded from asserting the issue.

It is clear that the issue of genericness was not pled, nor was it tried by implied consent of the parties, as is

the prerequisite for the pleadings to be considered amended under the provisions of FRCP 15(b). Accordingly, we have given no consideration to opposer's claim that the term "turbo" is generic, when used in connection with portable electric fans.

The two grounds which are before us are whether the mark TURBO is merely descriptive of applicant's goods and whether the mark sought to be registered, i.e., TURBO, is a mutilation of the mark or marks shown on the specimens of record.

The second ground for opposition can be dismissed summarily. Although the specimens show use of the composite phrase AIR DURACRAFT™ TURBO FAN™, it is well established that individual components of a composite mark may be registered separately, so long as the element sought to be registered creates a separate and distinct commercial impression from the other elements and per se identifies and distinguishes the product from those of others. See *In re Berg Electronics, Inc.*, 165 USPQ 487 (TTAB 1969) and the cases cited therein. Here the house mark AIR DURACRAFT clearly serves as a separate and distinct mark from the product mark TURBO. Moreover, although opposer argues that, at the very least, applicant's mark is TURBO FAN, not TURBO, we find no need for applicant to include the generic term FAN as part of its claimed mark. TURBO is the term which is

being relied upon by applicant to distinguish its product from those of others; the word FAN is obviously no more than the name of the product in general.⁹ Thus, we find no mutilation involved in applicant's seeking to register the mark TURBO alone on the basis of use of the mark in the manner shown in the specimens of record.

The main issue in this proceeding is whether or not the mark TURBO is merely descriptive, as used with applicant's portable electric fans. As a corollary, if the mark TURBO is merely descriptive, the issue becomes whether or not applicant has shown that the mark has acquired distinctiveness, such that it is entitled to registration under the provisions of Section 2(f).¹⁰

Opposer takes the position that the term "turbo" is merely descriptive of a portable electric fan having certain characteristics or features, namely, one which is more powerful than others of comparable size. Opposer asserts

⁹ In the *Berg* case, the specimens show use of a composite mark which included the house mark BERG and the mark sought to be registered, GRIPLET. The word TERMINAL, the name of the goods, was set forth directly below the word GRIPLET and could easily have been considered a portion of the mark. Nonetheless, the Board found that GRIPLET to be the mark for the specific goods and thus capable of being separately registered.

¹⁰ Although opposer argues that in order for applicant to qualify its mark for registration on the basis of acquired distinctiveness, applicant must have made a claim under Section 2(f) in its application, this is not true. Opposer having raised the issue of descriptiveness, applicant is not to be deprived of showing acquired distinctiveness as a defense thereto, even though the application was not published under Section 2(f). See

that the trial testimony of opposer's witness Mr. Rosensweig supports use by opposer of the term "turbo" to indicate a more powerful fan. Opposer then points to applicant's packaging on which applicant uses language such as "unique turbo design means more power, less noise" [Applicant Exhibit 17] as evidence that applicant itself is defining "turbo" as meaning more powerful. In addition, opposer contends that there are at least five competitors of applicant who use the term "turbo" descriptively to signify a fan of greater power, as shown by the advertisements included in Opposer's Exhibit 9 for fan-containing appliances such as the Vidal Sassoon Turbo Hair Dryer (1057), the King of Fans ceramic heater with high-efficiency turbo fan (1076), and the DeLonghi Turbo Tech Heat Accelerator (1010).¹¹

Colonial Arms Corp. v. Trulock Firearms Inc., 5 USPQ2d 1678 (TTAB 1987).

¹¹ Opposer also argues that applicant is collaterally estopped from relitigating the issue of descriptiveness because applicant had abandoned a previous application for the mark AIR DURACRAFT TURBO FAN (S.N. 74/364764) after a disclaimer of AIR and FAN was required (not TURBO FAN as stated by opposer). This argument is without merit. There was no adjudication of the issue of descriptiveness of the term TURBO; in fact, an application later filed by applicant for the same mark issued as a registration with a disclaimer only of AIR and FAN.

Opposer's additional argument that the Office has already determined the issue of descriptiveness of the term "turbo," in that the mark TURBINE FAN was registered on the Supplemental Register, is equally without merit. Even though applicant may have equated the word "turbine" with "turbo" in an infringement suit against the user of a mark containing the term "turbine," this does not make the words synonymous for purposes of registration.

On the issue of acquired distinctiveness opposer argues that applicant has failed to come forth with sufficient evidence of secondary meaning. Specifically, opposer asserts that applicant has done little advertising or promotion per se; its sales have decreased in recent years; the sales volume for this particular fan in the total market is very small; and others have used and continue to use the designation TURBO for their products.

Applicant, on the other hand, argues that its TURBO mark is, at the most, suggestive, as applied to applicant's products. Applicant points out that in the dictionary references which applicant has made of record the term "turbo" is identified as a prefix derived from the word "turbine," a term inapplicable to applicant's small fans, and that "turbo" has no recognized meaning as "more powerful" or the like. In fact, argues applicant, the mark TURBO is incongruous when used with applicant's small plastic fans, and that if it had appeared likely that consumers would make the direct association of TURBO with the nature of applicant's fans "it would have been superfluous for Applicant to use the tagline 'Unique 7" Turbo Design Means More Power, Less Noise' on its packaging." [Brief p. 16-17].

Applicant goes on to argue that opposer's own use of TURBO as part of its trademarks, as well as its application

to register the mark TURBO BOX FAN, belies any contention by opposer that the term is descriptive. Applicant maintains that other competitors in the relevant field have also used the term only in a non-descriptive manner and that applicant has taken action to restrain this use of TURBO as a trademark, such as by requiring opposer to cease use of its marks and acquiring the TURBO-AIRE mark of Seabreeze. Applicant insists that opposer's evidence of use of "turbo" in connection with products other than fans per se is irrelevant, and even if considered, the use is often as part of a mark, not in a descriptive manner. Applicant argues that neither opposer nor its competitors need the term "turbo" to describe their portable fans, that words such as "powerful," "high velocity," or the many synonyms for "powerful" serve just as well.

On the issue of acquired distinctiveness, applicant takes the position that opposer has the burden of proving that the mark has not become distinctive and that opposer has failed to carry this burden. Even if opposer had, applicant insists that its evidence of the extent of use of TURBO "as the name for its fan products"; the popularity of the DT-7 model; and the prominence of its TURBO mark in advertisements by retailers for applicant's fans supports a finding of acquired distinctiveness. Applicant further points to the testimony of its witnesses as to applicant's

exclusive use of the TURBO mark in the portable electric fan field. Applicant has acquired the TURBO-AIRE mark of Seabreeze and opposer has ceased use of TURBO as other than a speed setting.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, purpose, feature or function of the goods or services with which it is being used. Whether or not a particular term is merely descriptive is not determined in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is being used, and the significance the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods or services bearing the mark. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Nibco Inc.*, 195 USPQ 180 (TTAB 1977) and the cases cited therein.

In the present case, we find that opposer has met its burden of proving that TURBO as used by applicant is merely descriptive of the basic characteristics or features of its portable electric fans.

The strongest evidence that TURBO will be viewed by the purchasing public as descriptive of features of applicant's fan is the manner of use of the term "turbo" by applicant itself in the packaging of its personal fan. In applicant's

Exhibit 18 (the original packaging), the designation AIR DURACRAFT™ TURBO FAN™ is directly followed by the phrase "Unique 7" Turbo Design Means More Power, Less Noise!" while on another portion of the packaging, the fan is described as having a "Quiet, powerful 2-speed turbo design." In the more recent packaging (Applicant's Exhibit 17), the fan is similarly described in terms of its "Efficient 7" turbo design" and that the "Unique Turbo Design Means More Power, Less Noise!" Thus, while applicant may argue that the standard dictionary definitions of the term "turbo" are not applicable to its small personal fan, applicant itself has given another meaning to the term "turbo," as applied to portable electric fans. The taglines and informational text used by applicant in its packaging make clear to purchasers that "turbo" as applied to its fan is not simply a reference to any resemblance in appearance the fan may have to a jet engine. Instead, it directly conveys the information that this fan is more powerful than other fans of comparable size. Similarly, in the catalog sheets distributed to retailers, applicant's direct customers, which promote applicant's fans (Applicant's Exhibits 21-23), applicant not only refers to its fans in language such as "our new turbos" or "our unique turbos" but also provides information such as "it may look like a jet engine but the Air Duracraft™ is actually extremely quiet"; it "blows more air than other

fans of its kind"; and one of its major features is a "high pitch turbo blade." Throughout its packaging and promotional materials applicant uses "turbo," as a definitive term for particular features of its fan, i.e., that by its design, it is more powerful than other comparable personal size fans. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991)[applicant's use of MULTI-VIS in advertisements as part of informational matter about the goods, and in close proximity to language touting the "multi-viscosity" feature of the motor oil, provides evidence of the descriptive significance of the term].

Thus, we find that applicant, from the introduction of its fans in 1991, has been using the term "turbo" in a descriptive manner both before its immediate customers (the retailers) and the ultimate purchasers of the portable fans. The term "turbo" has been equated with "more powerful," the same meaning for which opposer claims to have used the term in its TURBO marks, and clearly the meaning imparted by opposer in using "turbo" as the highest speed setting. Although applicant argues that its competitors in the portable fan field have only used the term in a non-descriptive manner, this is of little significance when applicant itself has taken great pains to describe just how applicable the term "turbo" is to its fans, not just in terms of appearance but in terms of function. As for

opposer's evidence of use of the term "turbo" by others for other electric appliances which contain a fan element, even if this usage is as part of a mark, "turbo" once again is descriptive of a high degree of power for the fan element.

The question thus turns to whether applicant is entitled to register the mark under Section 2(f), on the basis of acquired distinctiveness. Here, contrary to applicant's arguments, the burden of proof lies with applicant and not opposer, since applicant is the one asserting acquired distinctiveness as a defense to any holding of mere descriptiveness. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

"To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n.11 (1982). The burden is upon applicant to demonstrate that the term TURBO, when viewed by potential purchasers of applicant's portable electric fans, would be associated by these purchasers with the source of the fan, rather as a descriptor of features of the fan. We find that applicant has failed to meet this burden.

We agree that applicant has submitted sales and market percentage figures demonstrating an outstanding and continued level of success for its TURBO fans since its introduction in 1991. But as it has frequently been stated, the popularity of a product cannot be equated with recognition of a designation used in connection with this product as an indication of source. See *In re Bongrain International (American) Corp.*, 842 F.2d 1316, 13 USPQ 1727 (Fed. Cir. 1990); *In re Recorded Books Inc.*, 42 USPQ2d 1276 (TTAB 1997). Even if applicant may have been successful in forcing others to cease use of TURBO in a trademark sense, applicant has not been as successful in establishing recognition of its own use of TURBO as a trademark, rather than as a descriptor of characteristics or features of a fan being marketed under the AIR DURACRAFT or DURACRAFT mark.

Applicant has presented testimony to the effect that its fans are promoted to consumers by means of co-op advertising done by retailers. Although in most of the retail advertisements introduced by applicant (Applicant's Exhibit 5), the term TURBO is found in close proximity to the DURACRAFT or AIR DURACRAFT mark, so as to be perceived as a part of the composite mark for the product, in a few cases the phrase "7 in. Turbo" is used in the same ad as a description of the fan. On the other hand, opposer has made of record a much greater number of advertisements (Opposer's

Exhibit 9) which show this descriptive use of the term "turbo" by retailers in advertising applicant's product. In many of these advertisements, we find the terms "personal turbo fan" (1001), a "desk top turbo fan" (1008), "turbo fan" (1009), or "7" turbo fan" (1021) being used to describe applicant's fan, with DURACRAFT the sole source indicator. In view of this inconsistent use of the term "turbo", i.e., sometimes as an indication of source, but more frequently as a descriptor of fan characteristics, we find that applicant has failed to prove that purchasers would make the requisite association of TURBO with the source of the fan. While these advertisements may not have originated from applicant, it was applicant's duty to police the use of its mark by retailers handling its products. Here, as in the advertisements for other fan-containing appliances, the impression created is that the term "turbo" describes the forcefulness or power of the fan, rather than the particular source thereof.

Accordingly, we find that the term TURBO is merely descriptive of applicant's portable electric fans under Section 2(e)(1) and that applicant has failed to establish acquired distinctiveness for the term under Section 2(f).

Decision: The opposition is sustained.

E. J. Seeherman

E. W. Hanak

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board